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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,988	12/24/2001	Tom A. Heynemann	20206-29 (P00-2952)	3636

7590

08/05/2004

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EXAMINER

MASON, DONNA K

ART UNIT

PAPER NUMBER

2111

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,988

Applicant(s)

HEYNEMANN ET AL.

Examiner

Donna K. Mason

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. (See page 4, lines 12-13 of the application).

Drawings

2. Figures 1, 2 and 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 1 and 4, the phrase "at least one read and at least one write buffer" renders the claims indefinite because it is unclear whether Applicant intends to claim at least one "read" or at least one "read buffer," thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).
6. Dependent claims 2, 3 and 5 inherit the deficiencies of their respective independent claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,432,918 to Stamm.

Stamm discloses an adapter unit, and a method for enforcing ordering between read and write transactions for an adapter unit configured to connect to a bus, the adapter unit having at least one read buffer and at least one write buffer, including: enqueueing, in the write buffer, an initiator write transaction to be performed on the bus (column 1, lines 64-66); receiving, in the read buffer, an initiator read transaction

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request to be performed on the bus, the performance, on the bus, of the initiator read transaction request being required to follow the performance, on the bus, of the initiator write transaction (column 2, lines 12-16); clearing a write contingency flag in a register associated with the read transaction request; if, after receiving the read transaction request, the performance of the initiator write transaction has not started on the bus: setting the write contingency flag in the register to indicate the dependence of the initiator read transaction request on the initiator write transaction in the write buffer; performing the initiator write transaction on the bus; after the performance of the write transaction is completed, clearing the write contingency flag in the register; and if the write contingency flag is not set, performing the read transaction request on the bus (*See generally*, column 2, lines 2-25).

Stamm also discloses an adapter unit, and a method for enforcing ordering between read and write transactions, further including: enqueueing a target read completion transaction in the write buffer, the target read completion transaction having a position in the write buffer either before or after the initiator write transaction based on whether the target read completion originally occurred before or after the initiator write transaction; and performing on the bus the transactions in the write buffer in the order in which the transactions were enqueued (*See generally*, column 5, lines 17-38).

Therefore, Stamm reads on the invention, as claimed.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No.

6,754,737 to Heynemann, et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims 1, 3, and 4 are generic to the method of enforcing ordering between read and write transactions for an adapter unit, the adapter unit having at least one read buffer and at least one write buffer, of claim 1 of U.S. Patent No. 6,754,737, and claim 1 of U.S. Patent No.

6,754,737 falls entirely within the scope of examined claims 1, 3 and 4. Likewise, the examined claims 2 and 5 are generic to the method recited in claim 2 of U.S. Patent No. 6,754,737, and claim 2 of U.S. Patent No. 6,754,737 falls entirely within the scope of examined claims 2 and 5.

More specifically, because a method of enforcing ordering for an adapter unit, the adapter unit having at least one read buffer and at least one write buffer containing a plurality of slots is a species of the generic category defined by a method of enforcing ordering of an adapter unit, the adapter unit having at least one read buffer and at least

one write buffer, the method of claims 1-5, which recite the generic category, is anticipated by claims 1 and 2 of U.S. Patent No. 6,754,737.

Conclusion

11. A shortened statutory period for reply is set to expire THREE MONTHS from the mailing date of this communication. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna K. Mason whose telephone number is (703) 305-1887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKM



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